

RECEIVED

OCT 26 2001

503.35443VX1

TC 2800 MAIL ROOM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): NAGAI, et al.

Serial No.: 09/493,210

Filed: January 28, 2000

For: CIRCUIT TAPE HAVING ADHESIVE FILM,
SEMICONDUCTOR DEVICE, AND A METHOD FOR
MANUFACTURING THE SAME

Group: 2815

Examiner: L. Cruz

*Transmitted
Response*

*10/36/01
L. Cruz*

RESPONSE

Assistant Commissioner for Patents
Washington, D.C. 20231

October 24, 2001

Sir:

In response to the rejections in the Office Action mailed April 24, 2001, in connection with which a Supplemental Office Communication was mailed July 12, 2001, Applicants respectfully submit the following comments, and enclosed certified English translation of Japanese Patent Application No. Hei 8-136159, filed May 30, 1996.

Specifically, note that all of the claims pending in the above-identified application have been rejected on prior art grounds (under 35 USC §103), the teachings of U.S. Patent No. 5,990,563 to Kim and of U.S. Patent No. 5,933,708 to Sim, et al., being used in each of the prior art rejections. However, note that U.S. Patent No. 5,990,563 to Kim has an earliest date for prior art purposes of November 8, 1996. Moreover, note that U.S. Patent No. 5,933,708 to Sim, et al. has an earliest date for prior art purposes of April 17, 1997. Moreover, note that each prior art date respectively of Kim and Sim, et al. is after the filing date of Japanese Patent Application No. Hei 8-136159 (filed on May 30, 1996), which is a priority application under 35 USC §119 for the above-identified application.

Note that Applicants have claimed priority, based on No. Hei 8-136159, under 35 USC §119 and 37 CFR §1.55, in the Claim For Priority submitted January 28, 2000 in the present application. As indicated in this Claim For Priority submitted January 28, 2000, a certified copy of No. Hei 8-136159 was filed on May 16, 1997, in prior application Serial No. 08/857,674, filed May 16, 1997. Acknowledgment by the Examiner of receipt of the claim for foreign priority, and of the certified copy of the priority document, was made in the Office Action mailed April 24, 2001, in the above-identified application.

Moreover, for satisfying requirements of 35 USC §119 and 37 CFR §1.55, enclosed please find an English translation of No. Hei 8-136159, filed May 30,

1996, with a Statement of Accuracy of this translation. In view of the present filing of the English translation with Statement of Accuracy thereof, it is respectfully submitted that all procedural requirements of 35 USC §119 and 37 CFR §1.55 have been satisfied, in connection with Applicants being accorded benefit of the filing date of No. Hei 8-136159.

In addition, as can be seen in the enclosed English translation, it is respectfully submitted that No. Hei 8-136159 is directed at the same invention, and supports the presently claimed subject matter under the requirements of the first paragraph of 35 USC §112. In this regard, attention is particularly directed to, for example, claim 3 on page 1 of the enclosed English translation; and especially to the description beginning from page 6 of the enclosed English translation. Note especially pages 6-19, and advantages as discussed on page 33, of the enclosed English translation.

In view of the foregoing, and particularly in view of the enclosed English translation with Statement of Accuracy, it is respectfully submitted that Applicants are to be accorded benefit of the filing date of Japanese Patent Application No. Hei 8-136159, filed on May 30, 1996, which is prior to dates, for prior art purposes, of the U.S. patents to Kim and Sim, et al. Accordingly, reconsideration and withdrawal of Kim and Sim, et al., as prior art; and,

accordingly, reconsideration and withdrawal of the prior art rejection in the Office Action mailed April 24, 2001, are respectfully requested.

Since the prior art rejection in the Office Action mailed April 24, 2001, is clearly improper, to facilitate proceedings in the present application, no further discussion of the prior art rejection will be made. Lack of further discussion is to facilitate proceedings, and does not constitute agreement with, or an admission as to propriety of, the prior art rejection; and also does not constitute agreement with, or an admission as to propriety of, arguments made by the Examiner in connection with the prior art rejection.

The provisional obviousness-type double patenting rejection as set forth in the Office Action mailed April 24, 2001, is noted. This provisional obviousness-type double patenting rejection is over claims 1-19 of co-pending application Serial No. 09/092,138.

However, note that a double patenting rejection has also been issued in No. 09/092,138, and Applicants therein have indicated the filing of a Terminal Disclaimer therein. Note that a Terminal Disclaimer has already been filed in No. 09/092,138, although not accepted as proper by the U.S. Patent and Trademark Office.

In addition, attention is respectfully directed to Manual of Patent Examining Procedure (MPEP), 822.01, at page 800-56. It is respectfully

submitted that by the present submission of the English translation of the Japanese priority application for the above-identified application, which clearly overcomes the prior art rejection, only the provisional double patenting rejection remains in the above-identified application. Thus, note the following from MPEP 822.01, at page 800-56:

If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

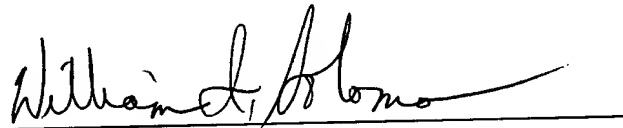
It is respectfully submitted that the present situation, upon overcoming the prior art rejection in the above-identified application, falls under the above-quoted guidelines from the MPEP. Thus, it is respectfully submitted that the Examiner should withdraw the provisional double patenting rejection in the above-identified application and permit the application to issue as a patent.

In view of the foregoing comments and submission of the English translation of Japanese Patent Application No. Hei 8-136159 with Statement of Accuracy, reconsideration and allowance of all claims in the above-identified application are respectfully requested.

To the extent necessary, Applicants petition for an extension of time under 37 CFR § 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Deposit Account No. 01-2135 (Case No. 503.35443VX1) and please credit any excess fees to such Deposit Account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP

A handwritten signature in cursive script, appearing to read "William I. Solomon", written over a horizontal line.

William I. Solomon
Registration No. 28,565

1300 North Seventeenth Street
Suite 1800
Arlington, VA 22209
Tel.: 703-312-6600
Fax.: 703-312-6666

WIS/alw